

## REMARKS

Claims 13-26 were examined and reported in the Office Action. Claims 21 and 23-25 are rejected. Claims 13-20 are canceled. New claims 27-31 are added. Claim 21 is amended. Claims 21-31 remain.

Applicant requests reconsideration of the application in view of the following remarks.

### I. 35 U.S.C. § 102(e)

It is asserted in the Office Action that claims 21 and 23-25 are rejected in the Office Action under 35 U.S.C. § 102(e), as being anticipated by U. S. Patent 6,594,059 issued to Flanders ("Flanders"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990))."

Applicant's amended claim 1 contains the limitations of "(f) etching said sacrificial oxide film with hydrogen fluoride such that said mirror is floated on said semiconductor substrate."

Flanders discloses a tunable Fabry-Perot filter. Flanders, however, does not teach, disclose or suggest "(f) etching said sacrificial oxide film with hydrogen fluoride such that said mirror is floated on said semiconductor substrate."

Therefore, since Flanders does not disclose, teach or suggest all of Applicant's amended claim 21 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(e) has not been adequately set forth relative to Flanders. Thus, Applicant's amended claim 21 is not anticipated by Flanders. Additionally, the claims that directly or indirectly depend on claim 21, namely claims 23-25, are also not anticipated by Flanders for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejection for claims 21 and 23-25 is respectfully requested.

## II. 35 U.S.C. § 103(a)

It is asserted in the Office Action that claims 23-24 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Flanders ('059). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claims 23-24 directly depend on amended claim 21. Applicant has addressed Flanders above in section I regarding amended claim 21. As discussed above, Flanders does not

teach, disclose or suggest “(f) etching said sacrificial oxide film with hydrogen fluoride such that said mirror is floated on said semiconductor substrate.”

Since neither Flanders does not teach, disclose or suggest all the limitations of Applicant's amended claim 1, as listed above, Applicant's amended claim 21 is not obvious over Flanders in view of no other prior art since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claim 21, namely claims 23-24, would also not be obvious over Flanders in view of no other prior art for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for claims 23-24 is respectfully requested.

### **III. Allowable Subject Matter**

Applicant notes with appreciation the Examiner's assertion that claims 22 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has added new claim 27, which corresponds to claim 26 re-written in independent form, including all of the limitations of the base and intervening claims.

Applicant respectfully asserts that claims 21-31, as they now stand, are allowable for the reasons given above.

**CONCLUSION**

In view of the foregoing, it is submitted that claims 21-31 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

**PETITION FOR EXTENSION OF TIME**

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on April 5, 2006, Applicant respectfully petitions the Commissioner for a two (2) month extension of time, extending the period for response to September 5, 2006. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$225.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(2) small entity. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: August 18, 2006

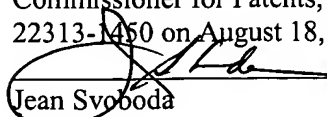
By: 

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on August 18, 2006.

  
Jean Svoboda